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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,109	10/15/1998	WITOLD A. ZIARNO		1294

7590

06/25/2002

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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary

Application No.
09/173,109

Applicant(s)
Ziarno

Examiner
John Young

Group Art Unit
2162



All participants (applicant, applicant's representative, PTO personnel):

(1) John Young

(3) _____

(2) Witold A. Ziarno

(4) _____

Date of Interview Oct 2, 2001

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal (copy is given to 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:

Claim(s) discussed: Independent claim 21.

Identification of prior art discussed:
Schneier text.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The Examiner stated that a request for reconsideration of the prior amendment would be received favorably. However, upon reconsideration, the Examiner will conduct additional prior art update searches. Also, the Examiner suggested that the Applicant consider that "If . . . the preamble merely states . . . the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). . . ." MPEP 2111.02 Weight of Preamble "PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE" 8th Ed. (August 2001) p. 2100-49.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Handwritten signature and date: 10-2-2001

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests "the Internet."

Schneier does not explicitly show a "kit further comprising the Internet." It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with a "kit further comprising the Internet. . . ." because the pervasiveness of the Internet would have been notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 37, Schneier shows the method of claim 32. (See the rejection of claim 32 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests "crediting or debiting an account."

Schneier does not explicitly show "crediting or debiting an account." It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with "crediting or debiting an account. . . ." because such procedures in electronic monetary transactions were notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 38, Schneier shows the method of claim 37. (See the rejection of claim 37 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests "sending a receipt comprising information representative of at least a portion of said monetary transaction data."

Schneier does not explicitly show "sending a receipt comprising information representative of at least a portion of said monetary transaction data." It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with "sending a receipt comprising information representative of at least a portion of said monetary transaction data. . . ." because such procedures in electronic monetary transactions of sending a confirmation or receipt associated with electronic monetary transactions were notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 39, Schneier shows the method of claim 34. (See the rejection of claim 34 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests "a multiplicity of personal computers."

Schneier does not explicitly show "a multiplicity of personal computers." It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with "a multiplicity of personal computers. . . ." because such implementation of multiple peripherals was notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 40, Schneier shows the method of claim 39. (See the rejection of claim 39 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests "a plurality of monitors."

Schneier does not explicitly show "a plurality of monitors." It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with "a plurality of monitors. . . ." because such implementation of multiple peripherals was notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 41, Schneier shows the method of claim 40. (See the rejection of claim 40 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests "a plurality of keyboards and speakers."

Schneier does not explicitly show "a plurality of keyboards and speakers." It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with "a plurality of keyboards and speakers. . . ." because such implementation of multiple peripherals was notoriously well known by one of ordinary skill in the art at the time of the invention.

RESPONSE TO ARGUMENTS—707.07(f)

7. The following is an excerpt of MPEP 707.07(f): "Where the [A]pplicant traverses any rejection, the examiner should . . . take note of the [A]pplicant's argument and answer the substance of it."

Applicant's arguments filed 4/25/2001, "Amendment C" (paper #8) have been fully considered but they are not persuasive for the following reasons:

Applicant's amendments to the claims increased the breadth of the claims and did not change the substance of the claims on the merits; and

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Applicant's arguments against the 35 U.S.C. §103(a) rejections fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention; furthermore,

Applicant's amendments to claims and the addition of claims 22 & 23, necessitated the new grounds of rejection presented in this Office action. Accordingly,

THIS ACTION IS MADE FINAL. SEE MPEP §706.07(a).

(11) *Response to Argument*

In response to Appellant's argument which suggests that a prima facie case of obviousness has not been established in the prior Office Actions, now comes the Examiner's response:

NOTE: The Examiner in the prior Office Action (paper# 11) relied upon Official Notice evidence in the rejections of claims 22-25 & 28-31. According to MPEP 2144.03 "If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant

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is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made.” In this case Applicant failed to seasonably challenge the Official Notice evidence relied upon in the obviousness rejections of claims 22-25 & 28-31 because Applicant has to date not made a demand for evidence; furthermore, Applicant failed to make a demand for evidence in any request for discretionary reconsideration during prosecution, following the reliance upon Official Notice; therefore, “the well known statement is taken to be admitted prior art. . . .” Id., and the reliance on Official Notice in the obviousness rejections of claims 22-25 & 28-31 must be upheld because.”

According to MPEP 2143.01 “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” In the rejections of claims 21-41 in the prior office action, the examiner meets the requirements of the motivation test for modifying by citing from Schneier cogent reasons to modify the teachings of Schneier to produce the claimed invention; furthermore the Examiner identifies how the Schneier reference either teaches or suggests the elements of the claims of the instant invention. ““There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the

knowledge of persons of ordinary skill in the art.' *In re Ruffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). . . ." (See MPEP 2143.01). Furthermore, the Examiner relies partly on knowledge generally available to one of ordinary skill in the art of Internet based electronic commerce and asserts that the teachings of the Schneier reference combined with the knowledge of one of ordinary skill in the art either teaches or suggests all of the elements and limitations of the instant invention. See the rejections of claims 21-41 in the prior office actions. Contrary to the allegation in Appellant's brief that the test is to "teach or fairly suggest" (Appellant's brief p. 9), "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.' *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." (See MPEP 2134.01).

Appellant's brief (page 13, line 35 and page 14, lines 1-2) alleges "The Examiner's rejection . . . is based solely upon that which the Examiner asserts is 'basic knowledge' or 'common sense' to one of ordinary skill in the art. . . ." However, the Examiner reiterates that the obviousness rejections of claims 21-41 are based on the teachings of the Schneier reference combined with the knowledge of one of ordinary skill in the art at the

time of the invention and said rejections are not based on per se "basic knowledge" or "common sense" evidence.

Appellant's brief perpetrates a disservice upon the Honorable Board; for example, Appellant's brief page 15 Chart One by presenting out of context arguments that tend to show that "credit or debit" cards are not contemplated by the Schneier reference is misleading. Appellant's brief fails to show that in the obviousness rejection of claim 21, the Examiner's Office Action reads in part:

As per claim independent claim 21, Schneier (pp. 117-124; pp. 428-435; pp. 296-297; & p. 436) suggests:

"An Internet linked computer peripheral as an input device for a personal computer or workstation comprising in combination: a smart card reader for reading credit and/or debit card information from an information bearing smart credit and/or debit card; and a secure link to the Internet."

In this case, Schneier (p. 117, lines 13-14) discloses: *"The existence of credit and debit cards has greatly reduced the amount of physical cash flowing through our society. . . ."*

Schneier (p. 120, lines 13-20) discloses: *"Practical implementations of this protocol might require Alice to wait by the cash register during the merchant-bank interaction, much the same way as credit-card purchases are handled today. . . . Unless the merchant keeps a database of money orders it already received, the merchant will be fooled."*

Schneier (p. 297, lines 13-15) in view of the above disclosures of Schneier contemplates the use of smart cards to solve credit/debit card problems related to digital cash transactions in industry and commerce.

Appellant's brief (p. 30, pp. 34-36, pp. 39-40 & pp. 41-42) alleges that impermissible hindsight is relied on to modify the Schneier reference "in such a way as to reconstruct the Applicant's claimed inventions as claimed in claims 21-41. The motivation and indeed, the blue print is taken from Applicant's disclosure." This is not the case.

In response to Appellant's argument (p. 30, pp. 34-36, pp. 39-40 & pp. 41-42) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In this case, the Examiner based

the obviousness rejections of claims 21-41 on the teachings of the Schneier as well as the knowledge of a person of ordinary skill in the art at the time of the invention. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

“Obviousness can only be established by . . . modifying [i.e., changing] the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” *Id.* In this case the prior Office Action supplies either “some teaching, suggestion, or motivation . . . [to modify] found either explicitly or implicitly in the reference or in the knowledge generally available to one of ordinary skill in the art.” *Id.*

Appellant’s brief (page 34, lines 1-6) alleges that the “Examiner concedes that Schneier fails to teach all of the elements claimed in claim 21. . . .”; however, this is not the case. The phrase “does not explicitly show. . . .” must not be incorrectly construed as a concession of a deficiency in the obviousness rejection. To the contrary, the phrase “does

not explicitly show. . . .” is merely the transition phraseology to the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2d 545 (1966), 148 USPQ 459 and the 35 USC §103(a) Obviousness proposition that even though the Schneier reference does not explicitly recite the claimed elements and limitations verbatim, the reference does in fact suggest the claimed elements and limitations of the instant invention (please see the rejections of the prior Office Action which in the obviousness rejections presents citations from the Schneier reference that suggest the claimed elements and limitations); for example, as per claim 21, the prior Office Action recites:

As per claim independent claim 21, Schneier (pp. 117-124; pp. 428-435; pp. 296-297; & p. 436) suggests:

“An Internet linked computer peripheral as an input device for a personal computer or workstation comprising in combination: a smart card reader for reading credit and/or debit card information from an information bearing smart credit and/or debit card; and a secure link to the Internet.”

Schneier does not explicitly show “credit or debit cards” even though Schneier (pp. 296-297) suggests “credit or debit cards.” It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the Schneier’s (pp. 296-297) “*smart card*” disclosure of would have been selected in accordance with “credit

or debit cards" because smart credit and debit cards would have been notoriously well known by one of ordinary skill in the art at the time of the invention.

Therefore, taken in the context of the factual inquires set forth in *Graham v. John Deer Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and the 35 USC §103(a) obviousness rejection requirements, the prior Office Action recitations of "Schneier does not explicitly show. . . ." does not constitute an admission of any deficiency in the obviousness rejection; to the contrary such recitations merely provide the transition phraseology to the factual inquires set forth in *Graham v. John Deer Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and to the 35 USC §103(a) Obviousness proposition that even though the Schneier reference does not explicitly recite the claimed elements and limitations, the reference does in fact suggest the claimed elements and limitations of the instant invention; and therefore, the elements and limitations of the instant invention are rendered obvious.

In response to Appellant's argument that the Schneier reference is nonanalogous art, it has been held that a prior art reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Schneier (pp. 117-124; pp. 428-435; pp. 296-297; & p. 436) shows that it is a

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reference both in the field of Appellant's endeavor or, as well as, reasonably pertinent to the particular problem with which the Appellant was concerned.

The arguments in Appellant's brief (pp. 36-38 & pp. 43-53) amount to a general allegation that the Schneier reference does not disclose elements and limitations of the instant invention. The arguments supply no substantial evidence to support said general allegation; therefore, the rejections of claims 21-41 must be sustained.


(12) Examiner's Answer, Conclusion


For all of the reasons stated above, Appellant's brief fails to overcome the 35 U.S.C. §103 obviousness rejections of claims 21-41 of the instant invention. For the above reasons, the rejections should be sustained.

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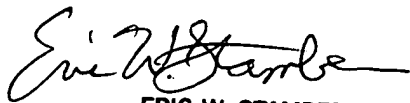
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Respectfully, presented,


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